

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Joseph Min H. Park
Serial No: 09/900,262
Filed: July 7, 2001
For: DEVICE FOR ELIMINATING POISONS
FROM THE HUMAN BODY AND FOR
REVITALIZING CELLS

Art Unit: 3763
Examiner: Thompson, Kathryn L.
Conf. No. : 7593

RENEWED PETITION UNDER 37 CFR 1.137(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is in response to the Decision on Petition under 37 CFR 1.137(b) dated May 14, 2009, in connection with the above-identified application. The response is due July 14, 2009. It is believed that no fee is due in connection with this paper as the petition fee was paid on January 29, 2009. Please charge any fees and credit any overpayment to our deposit account No. 502290. Please consider the following remarks:

REMARKS

The Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b) filed on January 29, 2009 was dismissed for lacking a "statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional," as indicated in the Decision on Petition under 37 CFR 1.137(b) (the "Petition Decision") mailed May 14, 2009. In particular, the Petition Decision indicated that the delay has not been shown to the satisfaction of the Director to be unintentional for the following periods:

- (1) the delay in reply that originally resulted in the abandonment; and
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application.

Examiner Interview

As a preliminary matter, Applicant notes with appreciation the courtesies extended by the Petition Examiner Brian W. Brown with regard to the June 25, 2009, telephone conversation between the Examiner and Applicant's representative, Jeffrey Lotspeich. The Examiner clarified the information needed for the present renewed petition and reiterated that Applicant is to explain why the abandonment was not intentional.

The following is believed to address the points noted by the Examiner in both the Petition Decision and those points raised during the telephone conversation. In particular, it will be demonstrated that the delay in filing the required reply occurred as a result of clerical error and the misidentification of the file associated with the subject application, and that there was never any intention or desire on the part of the Applicant to abandon the application.

Request for Statement:

On page 1 of the Petition Decision, the Examiner noted that a grantable petition under 37 CFR 1.137(b) must be accompanied by (1) the required reply; (2) petition fee; (3) statement stating that the entire delay was unintentional; and (4) any necessary

terminal disclaimer. The Examiner indicated that the instant petition lacks item (3). In response, Applicant and the undersigned respectfully submit:

That the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

Support for such a statement is presented below with regard to the noted time Periods (1) and (2), along with the materials provided in the included Appendix.

As to Period (1):

In rejecting the initial petition, the Examiner stated that in view of the delay (over 4 years) in resuming prosecution, there is a question as to whether the entire delay was unintentional. The time period at issue here for Period (1) appears to be the time between March 12, 2004 (mailing date of the Office Action) and January 29, 2009 (filing date of the response to the Office Action). With regard to this time period, the Examiner has requested the following items:

- (a) any renewed petition must clearly identify the party having the right to reply to avoid abandonment on June 13, 2004;
- (b) that the identified party must explain what effort(s) was made to further reply to the outstanding Office action;
- (c) why no reply was filed;
- (d) if no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction); and
- (e) statements from any and all person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action.

Regarding item (a), the Firm of Lee, Hong, Degerman, Kang & Waimey (the "Firm") has power of attorney to represent the Applicant (Mr. Joseph Min Park). The Firm was formally known as Lee & Hong. Accordingly, any of the then-registered attorneys or agents of the Firm had the right to reply to the Office Action of March 12, 2004, in the subject '262 application.

Regarding item (b), it is believed that this item requests explanation as to the efforts made to reply to the outstanding Office Action of March 12, 2004. For reasons

that will be discussed in more detail below, the Firm learned on or about January 20, 2009, that a reply to the outstanding Office Action was not filed with the USPTO. More specifically, on January 20, 2009, the Firm received a fax from the inventor of the instant '262 application. In the fax, the inventor inquired as to the status of the application.

Our investigation into this matter was then initiated and we learned that the '262 application had been abandoned for failing to respond to the outstanding Office Action. Within nine days after receiving the fax and subsequently discovering that the '262 application had been abandoned, a reply to the Office Action, along with a petition to withdrawal abandonment, were filed on January 29, 2009.

Regarding item (c), Applicant provides the following chronology of events as to why no reply was filed for the Office Action of March 12, 2004 (that is, why the reply was not filed until January 29, 2009). Applicant provides the following comments on this point, and invites the Examiner's attention to the chart depicted in the attached Exhibit. This chart provides a general chronological timeline of events relating to the abandonment and subsequent efforts to revive the subject application.

On July 7, 2001, the subject application (09/900,262) was filed and initially assigned the Firm's attorney docket number 2018-3-11. For clarity, this application will be referred to as the File 1 '262 application, or simply File 1.

Shortly after the filing of this application, in July 2001, it was discovered that docket number 2018-3-11 had already been assigned to a unrelated and previously filed patent application (App. Ser. No. 09/776,566), for a completely different client. Thus, at that point, there were two different patent applications assigned the same attorney docket number. This second application will be referred to as the File 2 '566 application as noted below, and again relates to App. Ser. No. 09/776,566, filed February 2, 2001. Since two patent applications have been assigned the same attorney docket number (2018-3-11), the docket number of the subject File 1 '262 application was then reassigned and given attorney docket no. 2086-3-01, and its related papers were placed into a folder labeled as such.

Thus, at this time in July 2001, the files at issue are:

File 1: 09/900,262 (2086-3-01)

File 2: 09/776,566 (2018-3-11).

Although the File 2 '566 application was entered into the Firm's electronic docketing system, the File 1 '262 application was never entered into this system. The following explains how, as it is best understood during our investigation into this matter, the File 1 '262 application was not entered into the electronic docketing system.

Ordinarily, upon the filing of a patent application, the physical application file is sent to docketing personnel for entry into the Firm's electronic docketing system. In the case of the File 1 '262 application, it could not be electronically docketed since it shared the duplicate docketing number (2018-3-11) with File 2. Although File 1 was later assigned a new docketing number (2086-3-01), this later-assigned docketing number (File 1) was mistakenly never associated with the application filing information of this file, and thus, File 1 was never electronically docketed. The physical file for the File 1 '262 application (now identified using docket no. 2086-3-01) was then placed into the file room without having undergone electronic docketing using the newly assigned docket number 2086-03-01.

Applicant emphasizes that because the inadvertent docketing number error noted above, the subject File 1 '262 application physically resides in a folder identified by docket number 2086-3-01, but this file was not entered into the Firm's electronic docketing system. Note that during our investigation into this matter, we found that the File 2 '566 application had indeed been electronically docketed, and that its application papers physically resided in a folder properly identified by docket number 2018-3-11.

On May 29, 2001, a Restriction Requirement was issued for the File 2 '566 application (2018-3-11). Client confidentiality prevents disclosing the circumstances relating to the abandonment of File 2 '566 application, but it suffices to say that a CIP application (Ser. No. 09/942,107, now U.S. 6,855,348) was timely filed on August 28, 2001, and which claims priority to the File 2 '566 application. We also emphasize that the client of the File 1 '262 application and the client of the File 2 '566 application are completely unrelated to each other. At about the time of the filing of the CIP application, the physical file associated with the File 2 '566 application was marked ABANDONED

on the outside of the folder. A similar entry was made in the electronic docketing system. Accordingly, at this point, both the electronic docket and the physical file of docket no. 2018-3-11 (for File 2) had been properly identified as being abandoned.

On March 12, 2004, the PTO mailed an Office Action for the File 1 '262 application. This Office Action for File 1 refers to attorney docket number 2018-3-11, which is the docket number for File 2, not File 1. In other words, the Firm received an Office Action for File 1, but this Office Action incorrectly refers to the application of the docket number of File 2. It appears that this Office Action was later remailed by the PTO on April 15, 2004, but this does not appear to have any significance to the matter at hand.

On April 21, 2004, the subject Office Action was received and considered by Michelle Park of the Firm. Ms. Park identified the docket number on the Office Action, which again incorrectly listed the docket number as 2018-3-11 (relating to File 2) instead of 2086-03-01 (relating to subject File 1). Ms. Park checked the electronic docketing system for docket number 2018-3-11 (File 2), and found that this file had been abandoned. To verify this status, Ms. Park then instructed via email a file clerk, Mary Viana, to check the physical file of 2018-3-11 (File 2) to confirm that this file was properly to be abandoned, and if so, to place the subject Office Action (File 1) into the file. See Appendix, pg. 3, showing the email from Ms. Park.

The file clerk apparently found the physical file for 2018-3-11 (File 2), noticed that the file had the word ABANDONED written across the front of the file, and then placed the Office Action (for File 1) into the file. It is believed that the file clerk verified only the docket numbers of the Office Action and the physical file (both being 2018-3-11) when confirming abandonment, and did not compare the serial numbers of these items, which are of course completely different. Note that during our January 2009 investigation into this matter, the physical folder for 2018-3-11 (File 2) was examined and it still included the word ABANDONED written on the front and had a copy of the subject Office Action (i.e., the Office Action for the File 1 '262 application) placed inside the file.

The abandonment notice for File 1 of December 16, 2004, was also found in the physical file docket number 2018-3-11 (File 2). It is again believed that the file clerk matched only the docket numbers when placing the PTO correspondence (this time the

abandonment notice) into the physical file labeled 2018-3-11 (File 2). At that time no concerns were raised with regard to the abandonment of 2018-3-11 since both the electronic docket and the physical file indicated that docket number 2018-3-11 (File 2) was ABANDONED. Although such abandonment may have been intentional for the File 2 '566 application, there was absolutely never any intention to abandon the subject File 1 '262.

As explained above, on January 20, 2009, a fax from the inventor of the File 1 '262 application was received at the Firm. The inventor requested a status update on the application. Our investigation into this matter was then initiated and it was learned that the File 1 '262 application had been abandoned, leading to the subsequent filing of a response to the outstanding Office Action and a petition to withdrawal abandonment on January 29, 2009. It is believed that the foregoing explains why no reply was filed for the identified time period.

Regarding item (d), explanation was requested that if no effort was made to further reply, then it must be explained why the delay in this application does not result from a deliberate course of action (or inaction). Applicant has addressed the requested "delay" explanation in item (c) above. Moreover, Applicant has demonstrated that even if there was an intention to abandon the File 2 '566 application, there was absolutely no intention, at any time, to abandon the subject File 1 '262 application.

Regarding item (e), the requested statement is provided by virtue of this renewed petition as submitted by the undersigned, who is the Firm's representative that investigated the abandonment of the subject application.

As to Period (2):

The Examiner next requests additional information relating to time Period (2), which relates to any delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application. It is understood that this additional information has been requested since the delay of filing a response of over four years could trigger such a request.

The time period at issue here for Period (2) appears to be the time between when Applicant first learned of the abandonment (January 20, 2009) and when the initial

petition was filed (January 29, 2009). With regard to this time period, the Examiner has requested the following items:

- (a) the date that the applicant first became aware of the abandonment of the application;
- (b) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant; and
- (c) statements from any and all person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

Regarding item (a), Applicant first became aware of the abandonment of the File 1 '262 application on January 20, 2009. This knowledge came as a result of the status inquiry from the inventor Mr. Park that was faxed to the Firm on that date. Upon receiving this status inquiry, a check of USPTO PAIR records revealed that the subject File 1 '262 application had been abandoned.

Regarding item (b), the time period at issue is believed to be from the date of abandonment (June 13, 2004), and the date that such abandonment was discovered (January 20, 2009). Applicant provided explanation above (time Period (1) item (c)), as to how the delay occurred in discovering the abandonment status of the subject application. It is evident that such delay was unintentional as Applicant never performed any course of action to intentionally abandon the subject File 1 '262 application. The abandonment of this application was by virtue of a clerical error, not by any intention or desire by the Applicant to abandon the application.

Furthermore, this delay in discovering the abandoned status of the application occurred despite the exercise of due care and diligence on the part of the Applicant. Examples of such due care and diligence (as described above in time Period (1) item (c)) include the Firm's use of an electronic docketing system, procedures for docketing applications upon their filing with the PTO, and Ms. Park's follow up to check the physical file after the electronic docket indicated that docket no. 2018-3-11 (improperly associated with the subject File 1) was to be abandoned. Despite such efforts by the

Firm, clerical errors were present, thus resulting in the delay in discovering the abandonment status of the subject application.

Regarding item (c), the requested statement is provided by virtue of this renewed petition as submitted by the undersigned, who is the Firm's representative that investigated the abandonment of the subject application.

CONCLUSION

The foregoing is believed to address the request for additional information involving the circumstances of the abandonment and subsequent efforts to revive the subject application. Applicant believes that the explanations and exhibits presented herein establish that the delay of the reply to the outstanding Office action did not result from a deliberate course of action to abandon the subject application. Favorable consideration of the renewed petition and revival of the application are respectfully requested.

If for any reason the Examiner finds the petition other than in condition for grant, the Examiner is requested to call the undersigned at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the petition in condition for grant.

Respectfully submitted,

LEE, HONG, DEGERMAN, KANG & WAIMEY

Date: July 8, 2009

By: /Harry S. Lee/
Harry S. Lee
Registration No. 56,814

Customer No. 035884

Appendix:

Date	Event
July 7, 2001	Filing date of the subject application (09/900,262), which will be referred to as File 1 as noted below. The File 1 '262 application was initially assigned attorney docket no. 2018-3-11, and later assigned attorney docket no. 2086-3-01.
July 2001	<p>It was discovered that docket no. 2018-3-11 (initially for the File 1 '262 application) had already been assigned to a unrelated and previously filed application for a different client. Thus, there were two applications assigned the same attorney docket number.</p> <p>This second application will be referred to as File 2 as noted below, and relates to App. Ser. No. 09/776,566, filed February 2, 2001.</p> <p>The subject File 1 '262 application was then assigned a second attorney docket no. (2086-3-01) and its related papers were placed into a folder labeled as such.</p> <p>Thus, at this time the files at issue are:</p> <p>File 1: 09/900,262 (2086-3-01) File 2: 09/776,566 (2018-3-11)</p>
May 29, 2001	<p>PTO issues a Restriction Requirement for the File 2 '566 application. On August 28, 2001, a CIP application (Ser. No. 09/942,107, now U.S. 6,855,348) was timely filed claiming priority to the File 2 '566 application. As a result of the CIP application, a response to the Restriction Requirement was not filed for the File 2 '566 application.</p> <p>At the Firm, the physical file associated with the File 2 '566 application was then marked ABANDONED to reflect its status.</p>
March 12, 2004	An office action was mailed for the File 1 '262 application.
March 30, 2004	The office action for the File 1 '262 application was returned to the USPTO as being undelivered.
April 15, 2004	The office action for the File 1 '262 application was re-mailed.

Date	Event
April 21, 2004	<p>The office action for the File 1 '262 application was received and considered by the Firm.</p> <p>The office action itself identified attorney docket no. 2018-3-11 (which actually relates to the properly abandoned File 2), instead of the actual File 1 docket no. of 2086-3-01.</p> <p>A Firm employee matched the docket number of the office action to the docket number on the physical file and saw that File 2 was properly abandoned. Thus no further action was taken on the Office Action (for File 1) as it was mistakenly believed that File 1 was to be abandoned.</p> <p>It is emphasized that the abandonment for File 1, not for File 2, is the subject of this petition.</p> <p>During our January 2009 investigation into this matter, the office action of April 14, 2004 for File 1 was found in the physical folder of File 2.</p>
June 13, 2004	The File 1 '262 application is deemed abandoned for failure to respond to the office action of April 15, 2004.
January 20, 2009	Fax from applicant for the File 1 '262 application was received at LHDK&W. The Applicant inquired about the status of the application.
January 29, 2009	Response to the office action of April 15, 2004 was filed along with a petition to withdrawal abandonment.